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EXAMINER				
CUTLER, ALBERT H				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Office Action Summary

**Application No.**

10/699,774

**Applicant(s)**

SUEHIRO, MASAKO

**Examiner**

ALBERT H. CUTLER

**Art Unit**

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8 and 10 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This office action is responsive to communication filed on June 17, 2009.

***Claim Objections***

2. Claim 10 is objected to because of the following informalities: Lack of clarity and precision. Claim 10 recites, "a transfer instruction device which sends a first instruction to ~~the the~~ image receiving apparatus". One "the" should be removed. Appropriate correction is required.

3. Any objections to the claims previously made by the Examiner are hereby withdrawn in view of Applicant's response.

4. The Examiner indicated that claims 1-6 were allowable in the office action mailed March 17, 2009. However, upon further consideration, the indicated allowability of claims 1-3, 5 and 6 is withdrawn in view of the newly discovered reference(s) to Hirose et al. (US 5,357,347) and Parulski et al. (US 7,027,172). Rejections based on the newly cited reference(s) follow.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirose et al. (US 5,357,347).

Consider claim 8, Hirose et al. teaches:

An image receiving apparatus ("Machine B", figure 1), comprising:

a communication device (bidirectional communication cable, 104, column 3, lines 4-7) which has

a first communication mode (monochromatic color mode, column 3, lines 39-42) for, on receiving an image capturing command from an image sending apparatus ("Machine A", figure 1), capturing in the image receiving apparatus (Machine B) an image selected and sent by the image sending apparatus (The monochromatic color mode is a possible communication mode for capturing an image selected and sent via instruction of machine A, column 8, lines 27-53, figures 6-1 through 7.), and

has a second communication mode (chromatic color mode, column 3, lines 39-42) enabling the image receiving apparatus (Machine B) to send images to the image sending apparatus (Machine A) for storage therein (Machines A and B are identical machines which perform bi-directional communication, column 2, line 65 through column 3, line 14, figures 1 and 2. Both machines have a key (240) for switching to a chromatic color mode in which chromatic color images are transmitted, column 3, lines 39-42, column 8, lines 27-53.);

a recording device which records the image selected and sent by the image sending apparatus (Machine A) through the communication device (See step S21 of

figure 5 and step S106 of figure 7, column 9, lines 20-23. When in a communication mode, a recording operation is performed in machine B.); and

a mode switch control device which sends an order to the image sending apparatus (Machine A) to control a switch between the first communication mode and the second communication mode (See steps S77, S79, S81 and S96, figure 6-1B, column 8, lines 54-66, column 9, lines 1-22. If Machine A is in the second communication mode (chromatic color mode, "yes", S77), and Machine B does not have color ink ("no", S81), then a command is sent from Machine B to Machine A to change the mode to black and white mode (i.e. monochromatic mode, S96).), wherein

on checking that there has been a transfer instruction received from the image sending apparatus (S79, figure 6-1B) through the communication device, the mode switch control device determines whether or not the communication mode with the image sending apparatus is the first communication mode (S81, figure 6-1B), and sends a conversion command ordering change to the first communication mode if determined that a current communication mode of the image sending apparatus is not the first communication mode (S96, figure 6-1B), and the mode switch control device controls the mode of the image sending apparatus based on checking that there has been the transfer instruction of the image selected by an image selecting device from a transfer instruction device of the image sending apparatus (See steps S77, S79, S81 and S96, figure 6-1B, column 8, lines 54-66, column 9, lines 1-22. If Machine A is in the second communication mode (chromatic color mode, "yes", S77), and Machine B does not have color ink ("no", S81), then a command is sent from Machine B to Machine A to change

the mode to black and white mode (i.e. monochromatic mode, S96). A transfer instruction is sent in step S79, and the mode switch is controlled in steps S81 and S96. The Examiner interprets start key (201) to be an image selecting device as it starts a sending operation, column 3, lines 15-16.).

Consider claim 10, and as applied to claim 8 above, Hirose et al. teaches:

An image sending apparatus (Machine A), comprising:

an image capturing device (image sensor, 301, figure 3) which captures an image (column 3, lines 59-63);

a first communication device (bidirectional communication cable, 104, column 3, lines 4-7) which has

a first communication mode (monochromatic color mode, column 3, lines 39-42) for sending an image selected by the image sending apparatus to the image receiving apparatus according to claim 8 (The monochromatic color mode is a possible communication mode for capturing an image in Machine B, selected and sent via instruction of machine A, column 8, lines 27-53, figures 6-1 through 7. See claim 8 rationale.), and

a second communication mode (chromatic color mode, column 3, lines 39-42) for enabling the image sending apparatus to function as an external recording device for the image receiving apparatus (Machines A and B are identical machines which perform bi-directional communication, column 2, line 65 through column 3, line 14, figures 1 and

2. Both machines have a key (240) for switching to a chromatic color mode in which chromatic color images are transmitted, column 3, lines 39-42, column 8, lines 27-53.);

a transfer instruction device (start key, 201) which sends a first instruction to the image receiving apparatus for instructing the image receiving apparatus to receive an image sent from the image sending apparatus (A transfer instruction is sent in step S79, and the mode switch is controlled in steps S81 and S96. The Examiner interprets start key (201) to be an image selecting device as it starts a sending operation, column 3, lines 15-16.); and

an automatic mode switching device which automatically switches at least to the first communication mode from the second communication mode in the first communication device upon receipt of a second instruction from the image receiving apparatus ordering the image sending apparatus to switch to the first communication mode from the second communication mode (See steps S77, S79, S81 and S96, figure 6-1B, column 8, lines 54-66, column 9, lines 1-22. If Machine A is in the second communication mode (chromatic color mode, "yes", S77), and Machine B does not have color ink ("no", S81), then a command is sent from Machine B to Machine A to change the mode to black and white mode (i.e. monochromatic mode, S96).), wherein

the second instruction is sent from the image receiving apparatus when the first communication device sends the first instruction (A transfer instruction is sent in step S79, and the mode switch is controlled in steps S81 and S96 (i.e. when the first communication device sends the first instruction).).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirose et al. (US 5,357,347) in view of Parulski et al. (US 7,027,172).

Consider claim 1, Hirose et al. teaches:

An image sending and receiving system (figure 1), comprising:

an image sending apparatus (Machine A) which comprises:

an image capturing device (image sensor, 301, figure 3) which captures an image (column 3, lines 59-63);



a recording device (head driver, 304) which records the captured image on a recording medium ("such as a sheet", column 1, lines 13-16, column 4, lines 6-8);

a first communication device (bidirectional communication cable, 104, column 3, lines 4-7) which has a first communication mode (monochromatic color mode, column 3, lines 39-42) for sending an image capturing command to an external device (Machine B) and sending the image selected to the external device (The monochromatic color mode is a possible communication mode for capturing an image in Machine B, selected and sent via instruction of machine A, column 8, lines 27-53, figures 6-1 through 7.), and

a second communication mode (chromatic color mode, column 3, lines 39-42) for enabling the image sending apparatus to function as an external recording device for the external device (Machines A and B are identical machines which perform bidirectional communication, column 2, line 65 through column 3, line 14, figures 1 and 2. Both machines have a key (240) for switching to a chromatic color mode in which chromatic color images are transmitted, column 3, lines 39-42, column 8, lines 27-53.);

a transfer instruction device (start key, 201) which outputs a transfer instruction for transferring the image selected to the external device through the first communication device (A transfer instruction is sent in step S79, and the mode switch is controlled in steps S81 and S96. The Examiner interprets start key (201) to be an image selecting device as it starts a sending operation, column 3, lines 15-16.); and

an automatic mode switching device which automatically switches between the first communication mode and the second communication mode in the first

communication device upon receipt of an order from the external device (See steps S77, S79, S81 and S96, figure 6-1B, column 8, lines 54-66, column 9, lines 1-22. If Machine A is in the second communication mode (chromatic color mode, "yes", S77), and Machine B does not have color ink ("no", S81), then a command is sent from Machine B to Machine A to change the mode to black and white mode (i.e. monochromatic mode, S96).); and

the external device includes an image receiving apparatus (Machine B) which comprises:

a second communication device (bidirectional communication cable, 104, column 3, lines 4-7) which performs at least communication in the first communication mode with the image sending apparatus (Machines A and B are identical machines which perform bi-directional communication, column 2, line 65 through column 3, line 14, figures 1 and 2.);

a recording device (head driver, 304) which records the image received through the second communication device (See step S21 of figure 5 and step S106 of figure 7, column 9, lines 20-23. When in a communication mode, a recording operation is performed in machine B.); and

a mode switch control device which orders the image sending apparatus to control a switch between the first communication mode and the second communication mode of the image sending apparatus (See steps S77, S79, S81 and S96, figure 6-1B, column 8, lines 54-66, column 9, lines 1-22. If Machine A is in the second communication mode (chromatic color mode, "yes", S77), and Machine B does not have

color ink ("no", S81), then a command is sent from Machine B to Machine A to change the mode to black and white mode (i.e. monochromatic mode, S96).), wherein:

on checking that there has been the transfer instruction of the image from the transfer instruction device of the image sending apparatus (S79, figure 6-1B), the mode switch control device of the image receiving apparatus determines whether or not the communication mode with the image sending apparatus is the first communication mode (S81, figure 6-1B), and sends a conversion command (S96, figure 6-1B) ordering change to the first communication mode if determined that a current communication mode of the image sending apparatus is not the first communication mode (See steps S77, S79, S81 and S96, figure 6-1B, column 8, lines 54-66, column 9, lines 1-22. If Machine A is in the second communication mode (chromatic color mode, "yes", S77), and Machine B does not have color ink ("no", S81), then a command is sent from Machine B to Machine A to change the mode to black and white mode (i.e. monochromatic mode, S96). The transfer instruction is sent at step S79.); and

on receiving the conversion command from the image receiving apparatus, the automatic mode switching device of the image sending apparatus switches the communication mode of the first communication device to the first communication mode (The image sending apparatus (Machine A) changes to the black and white mode (i.e. monochromatic mode), column 9, lines 15-24.).

However, Hirose et al. does not explicitly teach an image selecting device which selects a desired image of images recorded on the recording medium.

Parulski et al. similarly teaches of a printer (figure 2) with an imager (camera, 300), and of performing remote printing (see Abstract).

However, Parulski et al. additionally teaches an image selecting device which selects a desired image of images recorded on the recording medium (Parulski et al. teaches that images stored on a memory card (i.e. recording medium, 330) are displayed on a display (432) for user selection for printing via controls (430, figure 2), column 6, lines 27-37.).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to have the image sending apparatus taught by Hirose et al. include an interface for selecting images off of a recording medium as taught by Parulski et al. as a way of combining prior art elements according to known methods to yield predictable results.

Consider claim 2, and as applied to claim 1 above, Hirose et al. further teaches:  
the image sending apparatus further comprises a manual mode switching device (key, 240) which switches between the first communication mode and the second communication mode by manual operation (switches to the black and white mode, column 9, lines 12-14); and

the mode switching by the automatic mode switching device takes preference over the mode switching by the manual mode switching device (The mode is carried out automatically without the actuation of the switching device (240), column 9, lines 15-19.).

Consider claim 3, and as applied to claim 1 above, Hirose et al. further teaches:  
the automatic mode switching device of the image sending apparatus switches the communication mode of the first communication device to the second communication mode in a case where an initial communication mode was the second communication mode and a current communication mode is the first communication mode and it is in a non-connected state after connecting to the external device (During subsequent image printing, the switch (240) is consulted to determine the communication mode (step S61, figure 6-1A), column 7, lines 58-61.).

Consider claim 5, and as applied to claim 1 above, Hirose et al. further teaches that the image sending apparatus is one of a copying machine (a copying operation is performed, column 3, lines 15-16).

Consider claim 6, and as applied to claim 1 above, Hirose et al. further teaches that the image receiving apparatus is one of a printer (images are recorded (i.e. printed) by Machine B, column 8, lines 54-66).

***Allowable Subject Matter***

10. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALBERT H. CUTLER whose telephone number is (571)270-1460. The examiner can normally be reached on Mon-Thu (9:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/TUAN HO/  
Primary Examiner, Art Unit 2622

AC